

Amendments to the Drawings:

The attached sheet of drawings are replacement sheets as requested by the Examiner. These sheet includes changes to Fig. 1, which previously omitted reference numeral "10" that has been added. Acceptance of these replacement sheets is respectfully requested.

Attachment: Replacement Sheet

REMARKS/ARGUMENTS

This Amendment is in response to the Office Action mailed December 7, 2004. In the Office Action, claims 1-7, 11-14, 15-16, 17-21, 22 and 23 were rejected under 35 U.S.C. §102, and claims 8-10 were rejected under 35 U.S.C. §103. Applicants respectfully traverse these rejections in their entirety.

Herein, claims 1, 9, 11, 18 and 21 have been amended. Claims 8 and 22 have been cancelled without prejudice. Reconsideration and withdrawal of the outstanding rejections in light of the amendments and remarks made herein is respectfully requested.

Rejection Under 35 U.S.C. § 102

Claims 1-7, 11-14, 17-21 and 23 were rejected under 35 U.S.C. §102(b) as being anticipated by Walsh (USP 5,956,481). As the Examiner is aware, to anticipate a claim under 35 U.S.C. §102(b), Walsh must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicants respectfully submit that a *prima facie* case of anticipation has not been established because Walsh does not teach each and every element set forth in the above-identified claims.

In general, Walsh teaches virus protection operations within the computer itself without the exchange of any data with a remote computer or server to perform such virus protection operations. A first operation involves a virus protection routine in response to detection of an open file event. *See Col. 10, lines 17-21 of Walsh*. If the file includes characteristics associated with a virus, a notice is presented to advise the user that the file to be opened may contain a virus. *See Col. 10, lines 24-36 of Walsh*. The file may be opened in a "safe mode" where the macro or other components associated with a virus are not opened. *See Col. 10, lines 57-62 of Walsh*.

Walsh does describe a digital signature check. The digital signature check is conducted merely to confirm that a selected file has already been checked for viruses during a session, and thus, can be opened during the same session without virus protection. *See Col. 15, lines 34-41 of Walsh*.

With respect to independent claim 1, Applicants respectfully submit that a *prima facie* case of anticipation has not been established because Walsh fails to describe (i) a signature generator to produce a digital signature that includes the scanning result, (ii) file analyzer is adapted to preclude access to the incoming file unless a digital signature chain accompanies the incoming file and is verified, and (iii) the time stamp indicator as claimed. . Withdrawal of the §102(b) rejection as applied to claim 1 and those claims pending thereon is respectfully requested.

With respect to independent claim 11, Applicants respectfully submit that a *prima facie* case of anticipation has not been established because Walsh fails to describe the operation of sending a file to a signatory via a network, the signatory checking the file and providing a digital

signature chain indicating file integrity of the file and *timing information of the file checking operation* as conducted by the signatory, and (ii) verifying the *digital signature chain returned from the signatory* via the network prior to accessing the file. *Emphasis added.*

While page 4 of the Office Action alleges that such teachings are set forth on column 8, lines 54-56 and column 12, lines 56-61 of Walsh, Applicants respectfully disagree because these sections of Walsh are directed to the notion that the personal computer (20) featuring the virus protection software may be connected to a network. There is no teaching or suggestion of the virus protection software being deployed remotely from the personal computer opening the file in question. This differs from the claimed invention where file checking and digital signature generation are conducted remotely. Withdrawal of the §102(b) rejection as applied to claim 11 and those claims pending thereon is respectfully requested.

The arguments concerning independent claim 21 are similar to those set forth above with respect to claim 11. These arguments are incorporated by reference and withdrawal of the §102(b) rejection as applied to claim 21 is respectfully requested.

Moreover, claims 1, 11, 15-16 and 21-22 were rejected under 35 U.S.C. §102(b) as being anticipated by Spear (USP 6,611,925). Applicants respectfully submit that a *prima facie* case of anticipation has not been established because Spear does not teach each and every element set forth in the above-identified claims. For instance, with respect to claim 1, Spear fails to describe (i) a signature generator to produce a digital signature that includes the scanning result, (ii) file analyzer is adapted to preclude access to the incoming file unless a digital signature chain accompanies the incoming file and is verified, and (iii) the time stamp indicator as claimed.

With respect to claims 11 and 21, Applicants respectfully submit that a *prima facie* case of anticipation has not been established because Spear fails to describe the operation of a *signatory* checking the file and *providing a digital signature chain* indicating file integrity of the file and *timing information of the file checking operation* as conducted by the signatory, and (ii) verifying the *digital signature chain returned from the signatory* via the network prior to accessing the file. *Emphasis added.* Applicants respectfully request the Examiner to reconsider the allowability of these claims.

Rejections Under 35 U.S.C. § 103

Claim 8 was rejected under 35 U.S.C. §103(a) as being unpatentable over Walsh in view of Willman (USP 6,745,306). Moreover, claims 9-10 were rejected under 35 U.S.C. §103(a) as being unpatentable over Walsh in view of Willman and further in view of Reardon (USP 6,212,635). Claim 8 has been cancelled without prejudice. Claim 9 has been amended.

As the Examiner is aware, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *See MPEP §2143; see also In Re Fine, 873 F. 2d 1071, 5 U.S.P.Q.2d*

1596 (*Fed. Cir. 1988*). Herein, at a minimum, the combined teachings of the cited references do not describe or suggest all the claim limitations set forth in newly amended claim 9 wherein the second control unit is integrated as part of a chipset inclusive of the first control unit. In contrast, Reardon teaches a security gateway (12) integrated into a hard drive and floppy disk controller. *See col. 9, lines 10-11 of Reardon*. Withdrawal of the §103(a) rejections is respectfully requested.

In order to facilitate prosecution of the case, the Examiner is invited to contact the undersigned attorney for further discussion of the allowability of the pending claims if the Examiner still considers the claims not to be in condition for allowance. The undersigned attorney can be reached at the telephone number listed below.

Conclusion

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 03/07/2005

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Attachments

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Susan McFarlane

03/07/2005

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